

The indication in the Examiner's Answer of the reading of claim 1 is correct.

It should be noted that the indication in the Examiner's Answer of the Evidence Relied Upon fails to list the Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, dated 10 March 2008, which was entered into the record 12 March 2008.

Status of Claims (37 C.F.R. § 41.37(c)(1)(iii)):

The present Application, which is an application filed on 8 February 2005 under 35 USC § 371 from International Patent Application Serial No. PCT/US04/06552 filed on 3 March 2004 under the Patent Cooperation Treaty claiming the benefit of U.S. Provisional Patent Application Serial No. 60/500,311, filed on 4 September 2003, was originally filed with 35 claims (*i.e.*, claims 1-35).

In Appellant's amendment dated 9 April 2007 in response to the Office Action of 2 February 2007, claims 26-35 were canceled and new claims 36-40 were added. In Appellant's amendment dated 12 March 2008, claim 3 was canceled and no new claims were added. Thus, claims 1, 2, 4-25, and 36-40 are presently under consideration in the appealed Application.

In a Final Office Action dated 25 June 2008 ("Final Office Action"), the Office Action Summary indicates that claims 1, 2, 4-25, and 36-40 are finally rejected and that no claims are allowed or objected to.

The status of the claims is, therefore, believed to be as follows:

Allowed claims:	None
Claims objected to:	None
Claims rejected:	1, 2, 4-25, and 36-40
Claims canceled:	3 and 26-35.

Appellant hereby appeals the Examiner's final rejection of the foregoing claims (*i.e.*, claims 1, 2, 4-25, and 36-40), which presently stand rejected over the cited references.

Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. § 41.37(c)(1)(vi)):

Issue No. 1. Claims 1, 2, 4-25, and 36-40 stand rejected under 35 USC § 103(a), as being unpatentable over U.S. Patent 6,372,323 to Kobe *et al.* ("Kobe") in view of U.S. Patent 5,300,171 to Braun *et al.* ("Braun") and evidenced by U.S. Patent 6,960,272 to Tokas *et al.* ("Tokas"). Thus, the issue is whether the teachings of Kobe, Braun, and Tokas disclose or suggest all of the limitations of the rejected claims as necessary for establishing a *prima facie* case of obviousness.

In the Examiner's Answer, the Office requests that the "obviousness-type double patenting rejections of record be summarily affirmed."¹ Appellant respectfully asserts that these are **provisional** rejections, as the conflicting claims have not yet been patented. Accordingly, it would be improper for the Board to "summarily affirm" these rejections, as no actual rejections exist until the conflicting claims have been patented.

¹ Examiner's Answer, p. 11, ll. 3-4.

Argument (37 C.F.R. § 41.37(c)(1)(vii)):

Issue No. 1 – Rejection Under 35 USC §103(a) Over Kobe in view of Braun and evidenced by Tokas

In the Examiner's Answer concerning claim 1, the Office alleges that since Mr. Antonini's Declaration of 10 March 2008 ("Mr. Antonini's Declaration") "does not contain any evidence such as values of the elastic moduli or proof that the instant invention has property not found in the prior, the declaration is deemed unpersuasive."² Appellant respectfully asserts that the Office fails to properly appreciate the evidence provided in Mr. Antonini's Declaration. Mr. Antonini's Declaration explains that there is a relationship between elastic moduli and hardness, *i.e.*, that "elastomers having higher elastic moduli...exhibit higher hardnesses."³ Mr. Antonini's Declaration further states that "[i]f the stems in Kobe were too soft, they would not remain upstanding and would not channel away moisture, nor would they be able to engage with another slip control article."⁴ Thus, as pointed out in Mr. Antonini's Declaration, Kobe chooses elastomers with higher elastic moduli and, thus, higher hardnesses than the claimed "less than 30 on the Shore A scale."⁵ Kobe's exemplary elastomers confirm this interpretation. Even though the Office contends that "[o]ne of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 30 on a the *[sic]* Shore A hardness in order to insure flexibility,"⁶ Mr. Antonini's Declaration refutes this allegation as being unsubstantiated.

In the Examiner's Answer concerning claim 6, the Office now contends that "the method limitation 'polished' does impart structure to the film."⁷ As in *Garnero*⁸, discussed in the Appeal Brief, Appellant respectfully asserts that a "polished surface finish" is a structural limitation, not merely a method limitation that imparts structure to the film.

² Examiner's Answer, p. 13, ll. 18-20.

³ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, p. 2, l. 23.

⁴ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, p. 3, ll. 5-7.

⁵ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 7.

⁶ Examiner's Answer, p. 12, ll. 14-16.

⁷ Examiner's Answer, p. 14, ll. 7-8.

⁸ *re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969). See Appeal Brief, p. 14, l. 19, through p. 15, l. 15.

Appellant maintains that Kobe is completely silent with regard to any surfaces being having polished surface finishes, *i.e.*, polished on a microscopic scale, as required by claim 6. The Office has provided no reasoning establishing that Kobe's "non-raised/flat surface" exhibits a polished surface finish.

In the Examiner's Answer concerning claim 11, the Office alleges that the spaces between the projections in Kobe are depression areas. Therefore, Kobe discloses dimples.⁹ Even if the spaces between the projections in Kobe are depression areas and, thus, dimples, which Appellant disputes, Kobe fails to disclose an array of upraised dimples, as required by claim 11. Furthermore, the Office fails to provide any reasoned explanation as to wherein Kobe teaches upraised dimples.

In the Examiner's Answer concerning claim 12, the Office contends that "Appellant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art."¹⁰ The Office, however, has failed in its burden to make out a *prima facie* case of obviousness. The Office has arbitrarily deemed a surface having projections to be the claimed matte surface finish. Absent a rejection providing a reasoned, technical evidence that Kobe teaches a matte surface finish, the rejection is *prima facie* deficient and should be reversed.

In the Examiner's Answer concerning claims 13 and 36-40, the Office contends that "the limitation 'heat-stabilized' is a method limitation."¹¹ As discussed in the Appeal Brief, Appellant respectfully asserts that the term "heat stabilized" is a structural limitation in the same way "interbonded one to another by interfusion between the surfaces of the perlite particles" is a structural limitation in *Garnero*. Moreover, the Office alleges that "[t]he burden is on Appellant to show how the invention differs."¹² Appellant respectfully asserts that it is the Office's burden to first make out a *prima facie* case of obviousness, a standard which it has not met. If the reference relied upon fails to disclose the claimed feature, the rejection is *prima facie* deficient. The burden cannot pass to Appellant until the Office meets its burden of making out a *prima facie* case of obviousness.

⁹ Examiner's Answer, p. 15, ll. 2-3.

¹⁰ Examiner's Answer, p. 15, ll. 7-8.

In the Examiner's Answer concerning claim 16, the Office alleges that "Appellant has not clearly pointed out how the pigments and dyes or [sic] Kobe do not define graphical indicia."¹³ Attention is drawn to the Appeal Brief, which explains:

Claim 16 requires "graphical indicia associated with the plastic film." The Office relies upon Kobe to disclose "the plastic film or silicone elastomer can be tinted with pigments or dyes (col. 5, lines 62-67)."¹⁴ The cited portion of Kobe discloses:

The thermoplastic materials may also contain additives, including but not limited fillers, fibers, antistatic agents, lubricants, wetting agents, foaming agents, surfactants, pigments, dyes, coupling agents, plasticizers, suspending agents, hydrophilic/hydrophobic additives, and the like.

Kobe is describing, in general, the types of additives that its thermoplastic materials may contain. One of ordinary skill in the art would appreciate that these additives are of the type that are added to a batch of material, rather than to create a graphical indicia.

Thus, Kobe fails to disclose "graphical indicia associated with the plastic film," as alleged by the Office.

It should be noted that the Office has again failed in its burden to describe how the cited references are applied to claim 25. As in the Office Action of 14 December 2007, and the Final Office Action of 25 June 2008, while claim 25 is listed in the Detailed Action as being rejected under 35 USC § 103(a) over Kobe, Braun, and Tokas, the Office has failed in its burden to describe in the Examiner's Answer how the cited references are applied to claim 25. The Office's burden includes showing an objective teaching in the cited art that would lead one of ordinary skill in the art to combine the teachings of

¹¹ Examiner's Answer, p. 15, l. 16.

¹² Examiner's Answer, p. 16, l. 2.

¹³ Examiner's Answer, p. 16, ll. 7-8.

¹⁴ Final Office Action of 25 June 2008, Detailed Action, p. 6, ll. 20-21 (emphasis in original).

references.¹⁵ If not “readily apparent,” the examiner must explain why the combination of references is proper.¹⁶ No such explanation is provided. Appellant respectfully asserts that the cited references, whether taken singly or in combination, fail to disclose or suggest “a label stock having graphical indicia adhered to the plastic film, such that the graphical indicia is visible,” as required by claim 25. Accordingly, Appellant respectfully asserts that claim 25 is allowable over the cited references and respectfully requests the Board to affirm his assertion.

¹⁵ *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).

¹⁶ *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1790 (Bd. Pat. App. & Int. 1987).

Conclusion

In view of the foregoing reasons and the reasons stated in Appellant's Appeal Brief, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the Examiner's rejections as to all of the appealed claims.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. 502806.

Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.

Respectfully submitted,

13 July 2009
Date

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